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REMARKS

Responsive to the Office Action mailed May 6, 2005, Applicants provide the following. Claim 13 has been amended to address issues raised by the Examiner. No new matter has been added by this amendment. Twenty-four (24) claims remain pending in the application: claims 1-24. Reconsideration of claims 1-24 in view of the amendments above and remarks below is respectfully requested.

By way of this amendment, Applicants have made a diligent effort to place the claims in condition for allowance. However, should there remain any outstanding issues that require adverse action, it is respectfully requested that the Examiner telephone the undersigned at (858) 552-1311 so that such issues may be resolved as expeditiously as possible.

Claim Rejections - 35 U.S.C. 112

1. The Examiner has rejected claims 13-18 under 35 U.S.C. §112, second paragraph, indicating that these claims are indefinite as being directed to a system that only recites logic. Applicants have amended independent claim 13 to include "one or more computer readable mediums" that comprise the cited logic. The claim now recites hardware of a system. Therefore, claims 13-18 are not indefinite, and thus satisfy all of the requirements of 35 U.S.C. §112.

Claim Rejections - 35 U.S.C. 103

2. Claims 1-24 stand rejected under 35 U.S.C. 103(a), as being unpatentable over U.S. Patent No. 6,161,132 (Roberts et al.) in view of U.S. Patent No. 6,535,909 (Rust). Applicants traverse these rejections. The combination of the Roberts and Rust patents fails to teach all of the claim limitations of at least independent claims 1, 7, 13 and 19. Claim 1, for example, recites in part:

storing content and timing information transmitted during the simultaneous playback of the event at the host computer; and
allowing the content and timing information to be downloaded utilizing the network for playback of said event and said downloaded content and timing information after the simultaneous playback.

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The method of claim 1 allows "content and timing information to be downloaded" to be played back with the locally stored event. Therefore, the content and timing information is utilized with locally stored "event".

It is stated on pages 3-4 of the office action that Roberts et al. does not disclose storing content and timing information transmitted during the simultaneous playback of the event at the host computer, and allowing the content and timing information to be downloaded utilizing the network for playback of said event and said downloaded content and timing information after the simultaneous playback, and relies on the Rust patent suggesting that the Rust patent describes these limitations. However, the Rust patent does not teach or suggest allowing the downloading of the content and time information to be utilized with the locally stored event as claimed. Instead, the Rust patent specifically requires the remote "Control Server 140" to download to "the applet [to] receive all of the archived data from the Control Server 140 ... such that the Playback Client 150 views the previously recorded collaborative Web browsing session 100" (Rust, col. 10, lines 35-39, emphasis added). Therefore, the Rust patent does not teach or suggest "allowing the content and timing information to be downloaded" and played back with the locally stored event, and thus independent claim 1 is not obvious in view of the applied references.

Independent claims 7, 13 and 19 include language similar to that of claim 1 for "allowing the content and timing information to be downloaded" and played back with the locally stored event. Therefore, claims 13 and 19 are also not obvious in view of the applied references for at least the reasons provided above.

Similarly, claims 2-6 depend from claim 1, claims 8-12 depend from claim 7, claims 14-18 depend from claim 13 and claims 20-24 depend from claim 19. Therefore, claims 2-6, 8-12, 14-18 and 20-24 are also not obvious in view of the applied references for at least the reasons provided above.

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Still further, a declaration under 37 C.F.R. §1.131 is also submitted herewith demonstrating that Applicants conceived and reduced to practice the invention as claimed prior to the effective date of the Rust patent. Applicants note that Rust was not published more than one year before the filing date of the present application, thus, the Rust patent can not be used as a proper reference under 35 U.S.C. 102(b)/103(a).

In order to remove the Rust patent cited for the rejection of claims 1-24 under 35 U.S.C. 103 Applicants submit evidence demonstrating a reduction to practice of the claimed invention prior to the filing date of the Rust patent, i.e., prior to November 18, 1999; thus, overcoming a rejection under 35 U.S.C. 103(a) by establishing the invention of Applicants' claimed invention prior to the filing date of the Rust patent. This evidence is submitted in the form of the following declaration under 37 C.F.R. 1.131: the Declaration of Todd R. Collart, Evgeniy M. Getsin, and Michael J. Lewis (hereinafter referred to as "the 131 declaration"). Per MPEP 715.07, the dates have been blocked out of the exhibits attached to the 131 declaration; however, all dates are prior to November 18, 1999.¹

When any claim of an application is rejected, the inventor of the subject matter of the rejected claim may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the filing date of the reference on which the rejection is based.² A declaration submitted under 37 C.F.R. §1.131 is a proper response to a 35 U.S.C. 103(a). MPEP 715.03 specifically stated, "Applicant may overcome a 35 U.S.C. 103 rejection based on a combination of references by showing completion of the invention by applicant prior to the effective date of any of the references." (Emphasis added). Therefore, Applicants submit that the attached 131 declaration is proper in overcoming a 103(a) rejection.

Declaration Under 37 C.F.R. §1.131

3. Applicants submit herewith the 131 declaration for execution by all of the named inventors demonstrating that Applicants conceived and reduced to practice the invention

¹ The 131 Declaration, paragraph 3

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as claimed prior to the effective date of the Rust patent. A fully executed declaration will be submitted in due course, and probably received by the Examiner prior to reviewing this response.

The 131 declaration under 37 C.F.R. 1.131 must establish possession of either the whole invention claimed or something falling within the claim, in the sense that the claim as a whole reads on it.³ Proof of a reduction to practice of the invention prior to the filing date of the reference is sufficient to overcome a rejection based upon the reference.⁴ Generally, proof of an actual reduction to practice requires a showing that the apparatus actually existed and worked for its intended purpose.⁵

As established in the 131 declaration, an online synchronization system was used prior to November 18, 1999 that allowed multiple client devices to participate in the simultaneous playback "Ronin event" as described in Exhibit A, for example, at least on page 1 at about lines 10-21, and page 2 at about lines 11-22; Exhibit B, for example, at least on page 1, lines 8-31; Exhibit C; Exhibit D, for example, at least on page 1, at about lines 7-11; and Exhibit E, for example, at least on page 2, at about lines 6-10. Further, a host computer stored information for allowing playback of the same event, and that the contents and timing were made available on a web-site for playback at a later date prior to November 18, 1999, as evidenced at least by the publication of Exhibit D, at least on page 1, at about lines 10-11.⁶ Thus, the online event and storing of content for subsequent playback as described and evidenced in Exhibits A-E describe a device invented by Applicants falling within at least claims 1, 7, 13 and 19, i.e., claims 1, 7, 13 and 19 read upon such described device.

Therefore, given the 131 declaration and Exhibits A-E, it is respectfully submitted that Applicants have provided evidence demonstrating that a system, method and/or computer program invented by Applicants and covered under claims 1, 7, 13 and 19 existed prior to November 18, 1999, that it *worked for its intended purpose* such that an event allowing multiple users to participate in a "first live DVD online event" took place, and that content and timing

² 37 CFR § 1.131(a) and MPEP 715

³ *In re Tanczyn*, 347 F.2d 830, 146 USPQ 298 (CCPA 1965) and MPEP 715.02

⁴ 37 CFR 1.131(b) and MPEP 715.07

⁵ MPEP 715.07

⁶ The 131 Declaration at least Paragraph 7, Exhibit D

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information could be later downloaded utilizing the network by accessing the archived event at an identified Internet site for playback of said event after the simultaneous playback (see at least, Exhibit D, page 1, lines 9 and 14-15, respectively).⁷

Thus, as required under MPEP 715.07, it is submitted that an online synchronization system invented by Applicants that includes all of the limitations specified in at least claims 1, 7, 13 and 19 *existed prior to November 18, 1999* and that the inventor recognized that the device *worked for its intended purpose prior to November 18, 1999*.

The Examiner further suggested on page 8, paragraph 17 of the office action that Applicants did not indicate that the Exhibits provided are Applicants' own invention. Applicants submit that the newly submitted 131 declaration states in Paragraph 10 (and at least paragraph 8 of the 131 declaration submitted March 21, 2005), where Applicants declare that the system utilized to provide the synchronous online event and later playback of the event was the system invented by the Applicants and covered by the pending claims of the subject application.

Thus, Applicants respectfully submit that a rejection of claims 1-24 under 35 U.S.C. § 103(a) is overcome, and that claims 1-24 are in condition for allowance.

Request for Information Under 37 C.F.R. §1.105

4. The Examiner has further requested additional information under 37 C.F.R. §1.105 relating to: (1) earliest dates for public demonstrations of the invention that is encompassed by the currently pending claims; and (2) earliest dates as to when this invention was publicly known or used by others including dates when the invention that encompasses the currently pending claims was sold or licensed to be used.

The earliest date of public demonstration was prior to the November 18, 1999 date, but less than one year of the filing date of the subject application, i.e., after January 20, 1999. Specifically, Applicants and Assignee believe the first public disclosure was during an interview for the article published through "The Cinema Laser" accessible at least through the internet at the internet site: "www.thecinemalaser.com/ronin-special-report.htm", which is

⁷ The 131 Declaration Paragraphs 6, 7 and 8

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provided as Exhibit B of the 131 declaration attached herewith. Similarly, the earliest date that the invention encompassing the currently pending claims was publicly known was for the "The Cinema Laser" interview.

The invention that encompasses the currently pending claims was first licensed or sold less than one (1) year prior to the filing date of the subject application, i.e., after January 20, 1999. The first licensing of an invention encompassing the pending claims was for the on-line "Ronin" event described in Exhibits A-B accompanying the 131 declaration attached herewith. Applicants submit as "ATTACHMENT I" an invoice from the Assignee (InterActual Technologies, Inc.) to MGM Home Entertainment requesting payment for a "Software license fee" with respect to the "Ronin" on-line event (the dollar amounts have been crossed out as these amounts are not relevant to the examination of the subject application). Applicants note that the date of the invoice (i.e., February 10, 1999) is less than one year prior to the January 20, 2000 filing date of the subject application.

It is Applicants' and Assignee's understanding that there were no public disclosures or offers for sale that would constitute prior art or prior acts under 35 U.S.C. 102. Therefore, Applicants and Assignee have not submitted documentation regarding any such disclosures in accordance with the duty of candor under 37 CFR 1.97 as Applicants and Assignee believe that no disclosures constituting acts or prior art occurred that are material to patentability.

Applicants believe they have provided all of the information requested by the Examiner in the §1.105 request in accordance with MPEP §704.11 (i.e., earliest date of public demonstration, and earliest date with respect to licensing or sale, as requested in paragraphs 22 and 23, respectively, of the office action). If the Examiner would like additional information, Applicants respectfully request the Examiner contact Applicants' representative by telephone to discuss the additional information so that such information if deemed necessary can be forwarded to the Examiner to avoid further delays and speed the prosecution of the subject application.

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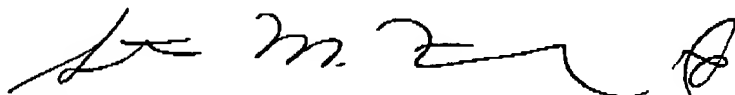
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CONCLUSION

Applicants submit that the above amendments and remarks place the pending claims in a condition for allowance. Therefore, a Notice of Allowance is respectfully requested.

Respectfully submitted,

Dated: 8-8-05


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Attachments: ATTACHMENT I
the 131 declaration, with Exhibits A-E

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